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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|------------------------|---------------------|------------------|
| 10/038,319 | 10/19/2001 | Markus Wilhelm Altmann | CM2462 | 7232 |

27752 7590 05/03/2004

THE PROCTER & GAMBLE COMPANY
INTELLECTUAL PROPERTY DIVISION
WINTON HILL TECHNICAL CENTER - BOX 161
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CINCINNATI, OH 45224

EXAMINER

BOYER, CHARLES I

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1751

DATE MAILED: 05/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/038,319 | Applicant(s) ALTMANN ET AL. | |
| | Examiner Charles I Boyer | Art Unit 1751 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 19 October 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>04/21/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 13, and 15-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Canivenc, US 5,540,952.

Canivenc et al teach a textile softening process using a composition comprising a polyorganosiloxane with a sterically hindered functional group (see abstract). The softener of Canivenc et al appears to be identical, and used for the identical purpose, that is, fabric softening, as the softener of the present claims. Regarding applicant's recitation of what is disclosed by the instructions, "Where sole distinction set out in claims over prior art is in printed matter, there being no new feature of physical structure and no new relation of printed matter to physical structure, such claims may not be allowed; it is only where claims define either new features of structure or new relations of printed matter to structure, or both, which new features or new relations give rise to some new and useful function, effect, or result, that claims may be allowed; particular branch of art considered does not change these principles." *Ex parte Gwinn* 112 USPQ 439. As the compositions are identical, and the instructions do not give rise to a new and useful function, effect or result, they do not contribute a patentable difference to applicant's invention. While instructions for use will necessarily impact the way a

product is used, the physical structure of the product itself is completely unaffected by the instructions, whatever they may recite. No patentable weight is given to instructions which are construed as intended use of the solution. *In re Gulack*, 217 USPQ 401, 404.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Canivenc et al, US 5,540,952.

Canivenc et al teach a textile softening process using a composition comprising a polyorganosiloxane with a sterically hindered functional group (see abstract). The softener of Canivenc et al appears to be identical, and used for the identical purpose, that is, fabric softening, as the softener of the present claims. Applicants acknowledge this on page 2, lines 12-16 of the present specification which reads "The use of aminosilicones comprising sterically hindered functional groups to treat textiles in an industrial context has been disclosed in US 5,540,952." Applicants appear to be basing their claim of patentability on the fact that their claims are drawn to a "domestic" process, and not an industrial process as taught by the prior art. The examiner maintains however, that one of ordinary skill in the art, having in their possession a composition with a proven utility of fabric softening in an industrial process, would have

a reasonable expectation of success when using the same composition for the same reason, albeit in a domestic process. Expected beneficial results are evidence of obviousness, just as unexpected beneficial results are evidence of unobviousness. *In re Skoll* (CCPA 1975) 523 F2d 1392, 187 USPQ 481; *Ex parte Luck* (BPAI 1993) 28 PQ2d 1875. Changes in temperature, concentrations, or other process conditions of an old process do not impart patentability unless the recited changes are critical, i.e., they produce a new and unexpected result. *In re Aller et al* (CCPA 1955) 220 F2d 454, 105 USPQ 233. Furthermore, the composition being used in a domestic process could be construed as an intended use of the composition. It is well established that the mere recital of a different intended use in a claim does not distinguish the claim over a composition containing the same ingredients in the same proportions for a different purpose in the prior art. See *In re Zierden*, 162 USPQ 102 (CCPA 1969). Claims in a patent application cannot be held to involve invention if the composition defined in such claims is not novel, and patents for old compositions of matter based on new use of such compositions without change therein may not lend patentability to claims. See *In re Thuau* 30 C.C.P.A. 979, 135 F.2d 344, 57 USPQ 324.

4. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Branlard et al, WO 97/33034.

Branlard et al teach a textile softening process using a composition comprising a polyorganosiloxane with a sterically hindered functional group (see abstract). The softener of Branlard et al appears to be identical, and used for the identical purpose, that is, fabric softening, as the softener of the present claims. Applicants appear to be basing their claim of patentability on the fact that their claims are drawn to a "domestic" process, and not an industrial process as taught by the prior art. The examiner maintains however, that one of ordinary skill in the art, having in their possession a composition with a proven utility of fabric softening in an industrial process, would have a reasonable expectation of success when using the same composition for the same reason, albeit in a domestic process. Expected beneficial results are evidence of obviousness, just as unexpected beneficial results are evidence of unobviousness. *In re Skoll* (CCPA 1975) 523 F2d 1392, 187 USPQ 481; *Ex parte Luck* (BPAI 1993) 28 PQ2d 1875. Changes in temperature, concentrations, or other process conditions of an old process do not impart patentability unless the recited changes are critical, i.e., they produce a new and unexpected result. *In re Aller et al* (CCPA 1955) 220 F2d 454, 105 USPQ 233. Furthermore, the composition being used in a domestic process could be construed as an intended use of the composition. It is well established that the mere recital of a different intended use in a claim does not distinguish the claim over a composition containing the same ingredients in the same proportions for a different purpose in the prior art. See *In re Zierden*, 162 USPQ 102 (CCPA 1969). Claims in a patent application cannot be held to involve invention if the composition defined in such claims is not novel, and patents for old compositions of matter based on new use of

such compositions without change therein may not lend patentability to claims. See *In re Thuau* 30 C.C.P.A. 979, 135 F.2d 344, 57 USPQ 324.

5. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirk, US 5,147,578.

Kirk teaches amino/polyalkoxylated polydiorganosiloxanes for use in textile softening compositions (see abstract). The softener of Kirk may contain cyclohexane or phenyl functional groups, thereby satisfying the "sterically hindered functional groups" limitation of the present claims (col. 2, lines 1-50). Accordingly, it would have been obvious to one of ordinary skill in the art to formulate a softening composition containing a sterically hindered functional group based on the teachings of Kirk and so meet the limitations of the claims at hand.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles I Boyer whose telephone number is 571 272 1311. The examiner can normally be reached on M-F 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 571 272 1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Charles I Boyer". The signature is written in a cursive, flowing style.

Charles I Boyer
Primary Examiner
Art Unit 1751